

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Andrew C. GILBERT (deceased)
Application No. : 10/042,371 Confirmation No. : 6761
Filed : December 27, 2001
For : CREATING AND TRADING DYNAMIC SECURITIES
Group Art Unit : 3692
Examiner : ONYEZIA, Chuks N.

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

Applicant requests review of the Final Rejection mailed April 4, 2007 in the above-identified application. No amendments are being filed with this request.

This request is being filed with a Notice of Appeal.

The review is requested for the reasons stated on the attached sheets.

REMARKS

For the following reasons, Applicant requests review of the Final Rejection mailed April 4, 2007 in the present application.

(A) The Examiner failed to establish a prima facie case of anticipation in rejecting claims 14, 25, and 43.

The Examiner rejected dependent claims **14, 25, and 43** under 35 U.S.C. 102(c) as being anticipated by Pritchard, U.S. Patent Application Publication No. 2002/0046154 (hereinafter Pritchard) (see the Office Action of April 4, 2007 at page 2 paragraph 2, which refers to the Office Action of November 9, 2006 at page 7 paragraph 17, at page 11 paragraph 28, and at page 17 paragraph 46).

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631 (Fed. Cir. 1987).

The Examiner failed to show that Pritchard discloses each and every element of any of claims **14, 25, and 43** and as such, failed to establish a *prima facie* case of anticipation with respect to these claims. Claim **14** is representative of the claims.

Claim **14** recites in part:

providing a notification when the rate of return deviates at a pre-determined ratio from the target rate of return.

The Examiner indicated that Pritchard paragraph [0018] discloses claim **14** (and similarly claims **25** and **43**) and in particular, referred to the following portion of paragraph [0018]:

[T]he financial data processing system may monitor the performance of the underlying investment instruments of the trust, as well as the trust itself, in order to generate reports to investors and/or brokers on the value of the trust and its underlying investment instruments, on the present and expected return of the investment and other information.

(emphasis added by the Examiner).

No where in paragraph [0018] does Pritchard disclose “a pre-determined ratio” and as such, Pritchard paragraph [0018] cannot disclose “providing a notification when the rate of return deviates at a pre-determined ratio from the target rate of return,” as claim 14 recites. A “present return of the investment” and an “expected return of the investment” as disclosed by Pritchard are not “a pre-determined ratio,” as recited by claim 14. Notably, in rejecting claim 13, from which claim 14 depends, the Examiner asserted that the “present return of the investment” and the “expected return of the investment” as disclosed by Pritchard are the same as the “rate of return” and the “target rate of return” of claim 14 (see the Office Action of April 4, 2007 at page 4, first paragraph). Accordingly, based on the Examiner’s assertion, the “present return of the investment” and the “expected return of the investment” of Pritchard are not the “pre-determined ratio” of claim 14. However, the Examiner failed to indicate what other aspect of Pritchard as disclosed in paragraph [0018] is “a pre-determined ratio.” Accordingly, the Examiner failed to indicate where Pritchard discloses “a pre-determined ratio” and as such, failed to show that Pritchard discloses claim 14.

Because the Examiner failed to show that Pritchard discloses each and every element of claim 14 (and similarly claims 25 and 43), the Examiner failed to establish a *prima facie* case of anticipation with respect to these claims.

(B) The Examiner failed to establish a prima facie case of anticipation in rejecting claims 17 and 46.

The Examiner rejected dependent claims 17 and 46 under 35 U.S.C. 102(e) as being anticipated by Pritchard (see the Office Action of April 4, 2007 at page 2 paragraph 2, which refers to the Office Action of November 9, 2006 at page 8 paragraph 20 and at page 19 paragraph 49).

The Examiner failed to show that Pritchard discloses each and every element of any of claims 17 and 46 and as such, failed to establish a *prima facie* case of anticipation with respect to these claims. Claim 17 is representative of the claims.

Claim 17 recites in part:

providing a notification when the value of a selected one of each of the selected plurality of assets deviates at a pre-determined ratio from the target rate of return.

The Examiner indicated that Pritchard paragraph [0017] discloses claim 17 (and similarly claim 46). At paragraph [0017], Pritchard discloses that

[t]he financial management system may provide a real-time update of all the instruments which comprise the investment trust, and may supervise, analyze and periodically report on the investment activities associated with the trust.

No where in paragraph [0017] does Pritchard disclose “a pre-determined ratio,” let alone “providing a notification when the value ... deviates at a pre-determined ratio from the target rate of return,” as claim 17 recites. In addition, as similarly discussed above, Pritchard paragraph [0018] does not disclose “a pre-determined ratio” and as such, does not disclose “providing a notification when the value ... deviates at a pre-determined ratio from the target rate of return,” as claim 17 recites.

Accordingly, because the Examiner failed to show that Pritchard discloses each and every element of claim 17 (and similarly claim 46), the Examiner failed to establish a *prima facie* case of anticipation with respect to these claims.

Conclusion

Because the Examiner failed to establish a *prima facie* case of anticipation with respect to claims 14, 17, 25, 43, and 46, withdrawal of the rejections is respectfully requested.

Respectfully submitted,

/Glen R. Farbanish/

October 4, 2007

Date

Glen R. Farbanish
Reg. No. 50,561
Attorney for Applicant
(212) 294-7733/phone
(212) 308-7537/fax